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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/043,856      | 01/11/2002  | Jean-Luc Pous        | 22.1489             | 8450             |

7590 09/01/2010  
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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

|           |               |
|-----------|---------------|
| MAIL DATE | DELIVERY MODE |
|-----------|---------------|

09/01/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE  
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4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES  
6  
7

8 *Ex parte* JEAN-LUC POUS, DAVID L. MALONE,  
9 IAN T. SCHUUR, and PETER A. GOODE  
10  
11

12 Appeal 2010-001334  
13 Application 10/043,856  
14 Technology Center 3600  
15  
16

17 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and  
18 BIBHU R. MOHANTY, *Administrative Patent Judges*.  
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL<sup>1</sup>  
21

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE<sup>2</sup>

Jean-Luc Pous, David L. Malone, Ian T. Schuur, and Peter A. Goode (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 42-62, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a way of supplying custom engineered products (Specification 2: Field of Invention). An understanding of the invention can be derived from a reading of exemplary claim 42, which is reproduced below [bracketed matter and some paragraphing added].

42. A method comprising:

[1] providing an online catalog on a computer,

the catalog having an unavailable product/attribute selector to select an unavailable product or attribute that is not offered for sale; and

[2] using selections of unavailable products or attributes that are not offered for sale obtained via the unavailable product/attribute selector as market research

to determine whether to extend a product offering that includes the unavailable products or attributes.

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<sup>2</sup> Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed June 8, 2007) and Reply Brief ("Reply Br.," filed November 5, 2007), and the Examiner's Answer ("Ans.," mailed September 4, 2007).

1 The Examiner relies upon the following prior art:

|        |                 |               |
|--------|-----------------|---------------|
| Joseph | US 5,878,401    | Mar. 2, 1999  |
| House  | US 6,785,805 B1 | Aug. 31, 2004 |
| Hunter | US 6,850,901 B1 | Feb. 1, 2005  |

2 *EMCORE Announces Expectations For Record Year End Revenue And*  
3 *Substantial Increases In 2001 Backlog.* Business Wire, October 30, 2000  
4 at p. 0144 (hereinafter referred to as “Emcore”)

5 Claims 42, 44, 45, 53, 54, and 56-59 stand rejected under 35  
6 U.S.C. § 103(a) as unpatentable over House and Emcore.

7 Claim 51 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
8 House, Emcore, Official Notice, and Hunter.

9 Claim 43 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
10 House, Emcore, and Joseph.

11 Claims 46-50, 52, 55, 60, and 62 stand rejected under 35 U.S.C. § 103(a)  
12 as unpatentable over House, Emcore, and Official Notice.

13 Claim 61 stands rejected under 35 U.S.C. § 103(a) as unpatentable over  
14 House, Emcore, Joseph, and Official Notice.

15

## 16 ISSUES

17 The issue of obviousness hinges on whether it was predictable for House  
18 to use data from product customization requests to extend its product line.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

*Facts Related to Claim Construction*

01. The disclosure states that “[a]n unavailable product/attribute [] is one that the seller does not currently offer and that requires engineering, testing, or both before it may be produced/sold.” Specification 6:9-11.

*Facts Related to the Prior Art*

*House*

02. House is directed to network-based methods for configuring and building integrated systems, such as integrated test, automation, and/or measurement systems. The methods may be internet or intranet-based applications that configure and price an integrated system in response to selection of system features and/or system configurations by a network user. House 1:16-18.
03. House provides online and offline selection tools to identify individual components. The components may be off the shelf or custom designed and made. House 2:12-27; 48-63.
04. The customized components may require engineering design and test services to complete. House 4:59 – 5:3; 5:34-40.

*Emcore*

05. Emcore is directed to a notice that Emcore would increase R&D expenditures to capitalize on new market opportunities. Emcore 1:1<sup>st</sup> ¶.

06. Emcore stated that such increases were in direct response to customer demand. Emcore 1:5<sup>th</sup> ¶.

ANALYSIS

Claims 42 and 56 are the only independent claims and the only claims argued. Accordingly the remaining claims stand or fall with their parent claims.

The Appellants argue that the art fails to show a reason for one to have expanded a product line based on selection of an unavailable product/attribute selector of an online catalog as required by limitation [2] of claim 42. Appeal Br. 10-11. The Examiner found that this was mere product development based on customer demands made apparent by requests for customization in House. Ans. 13-14. The Appellants characterize the Examiner's findings as an obvious to try analysis, and argue that the Examiner has not shown a solution to the problem in the art. Reply Br. 2-3. The Appellants also argue for the first time that House does not describe an unavailable product/attribute selector for an unavailable product or attribute that is no offered for sale. Reply Br. 3.

As to the most recent argument regarding whether House offers unavailable products, we find that the Appellants have acted as their own lexicographer and defined an unavailable product as "one that the seller does

1 not currently offer and that requires engineering, testing, or both before it  
2 may be produced/sold.” FF 01. House offers to add components it does not  
3 currently sell, but may be custom made, in its test systems. FF 03. These  
4 customized components may require engineering design and test services to  
5 complete. FF 04. Accordingly, we find that House does offer unavailable  
6 products in its online system (catalog).

7 As to the reason for combining the references to have expanded a  
8 product line based on selection of an unavailable product/attribute selector  
9 of an online catalog, the Examiner articulated a compelling line of reasoning  
10 that recognized customer demand would typically trigger an expansion in a  
11 product line with the rational underpinning being evidence in the form of  
12 Emcore. The Examiner elaborated on this at Answer 13-16 and we adopt  
13 those Examiner’s findings and rationale.

14 “[R]ejections on obviousness grounds cannot be sustained by mere  
15 conclusory statements; instead, there must be some articulated reasoning  
16 with some rational underpinning to support the legal conclusion of  
17 obviousness”). *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007)  
18 citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006).

19 This is not an obvious to try analysis, as one of ordinary skill would have  
20 known exactly how to implement the resultant method – merely observing  
21 sales statistics to decide to make standard what was already custom designed  
22 and built. This is standard product marketing fare.

23 Claim 56 is to a system that is used to perform the method of claim 42.  
24 Since this is a system claim, certain structural elements are added that are  
25 not explicit in claim 42, such as a processor to compile the selections. The

Appellants argue that the art fails to describe a processor to compile the selections as recited in claim 56. Appeal Br. 12. The Examiner responded that for House to see which custom designs (unavailable products) were worthy of making standard, some compilation must have been performed and House has the server that would have the capacity to do such a compilation. Ans. 16. We agree with the Examiner for those reasons.

#### CONCLUSIONS OF LAW

Rejecting claims 42, 44, 45, 53, 54, and 56-59 under 35 U.S.C. § 103(a) as unpatentable over House and Emcore is not in error.

Rejecting claim 51 under 35 U.S.C. § 103(a) as unpatentable over House, Emcore, Official Notice, and Hunter is not in error.

Rejecting claim 43 under 35 U.S.C. § 103(a) as unpatentable over House, Emcore, and Joseph is not in error.

Rejecting claims 46-50, 52, 55, 60, and 62 under 35 U.S.C. § 103(a) as unpatentable over House, Emcore, and Official Notice is not in error.

Rejecting claim 61 under 35 U.S.C. § 103(a) as unpatentable over House, Emcore, Joseph, and Official Notice is not in error.

#### DECISION

To summarize, our decision is as follows.

- The rejection of claims 42, 44, 45, 53, 54, and 56-59 under 35 U.S.C. § 103(a) as unpatentable over House and Emcore is sustained.



- 1 • The rejection of claim 51 under 35 U.S.C. § 103(a) as unpatentable  
2 over House, Emcore, Official Notice, and Hunter is sustained.
- 3 • The rejection of claim 43 under 35 U.S.C. § 103(a) as unpatentable  
4 over House, Emcore, and Joseph is sustained.
- 5 • The rejection of claims 46-50, 52, 55, 60, and 62 under 35  
6 U.S.C. § 103(a) as unpatentable over House, Emcore, and Official  
7 Notice is sustained.
- 8 • The rejection of claim 61 under 35 U.S.C. § 103(a) as unpatentable  
9 over House, Emcore, Joseph, and Official Notice is sustained.

10 No time period for taking any subsequent action in connection with this  
11 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.  
12 § 1.136(a)(1)(iv) (2007).

13  
14 AFFIRMED

15  
16  
17  
18 mev

19  
20 Address

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